REMARKS

Applicant hereby responds to the Office Action dated March 22, 2007. Applicant thanks the Examiner for carefully considering the application.

Disposition of Claims

Claims 1-15 are currently pending. Claims 1 and 12 are independent.

Claim Amendments

By way of this reply, claims 1-15 have been amended to correct minor informalities. No new matter has been added by way of this amendment and none of the amendments is made in view of prior art.

Rejections Under 35 U.S.C. 102(e)

Claims 1-4, and 6-8 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,698,020 ("Zigmond"). The rejection is respectfully traversed because for at least the following reasons, Zigmond does not disclose all of the claimed limitations.

The claimed invention is directed to a digital television receiver. Independent claim 1 requires, in part, (i) "maintaining a count of the number of the plurality of the advertisement messages that have been output by the digital television receiver;" and (ii) "if the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver." Independent claim 12 has similar limitations albeit in different forms. Zigmond fails to disclose

at least the limitations (i) and (ii).

In the instant Office Action (page 6, 18-19), the Examiner asserts that col. 13, lines 40-47 of Zigmond discloses "maintaining a count of the number of the plurality of the advertisement messages that has been output by the digital television receiver." Applicant respectfully submits that the Examiner's assertion is incorrect. Col. 13, lines 40-47 of Zigmond reads:

> "In one embodiment, statistics collection location 61 of FIG. 5 counts **the number of times** a **particular viewer** has seen a **selected advertisement**. Once the advertisement has been displayed the desired number of times during a given time period, further display of the advertisement to the viewer is blocked. This is useful, for example, to prevent viewers from becoming frustrated through being excessively exposed to the selected advertisement." (emphases added)

Thus, the rejection has been based incorrectly equating the following: (1) the number of times in the above-quoted passage of Zigmond has been incorrectly equated to the claimed "count of the number;" (2) a particular viewer in the above-quoted passage of Zigmond has been incorrectly equated to the claimed "digital television receiver;" and (3) a selected advertisement in the above-quoted passage has been incorrectly equated to the claimed "plurality of advertisement messages." Thus, Zigmond already fails to disclose the claimed limitation (i). Subsequently, Zigmond cannot possibly have disclosed the claimed limitation (ii) as limitation (i) is requisite of limitation (ii).

Applicant respectfully submits that the instant Office Action further incorrectly equates *blocking the selected advertisement* in the above-quoted passage of Zigmond to the claimed

"disabling the digital TV function" as in limitation (ii). As clearly described in the above-quoted passage of Zigmond, blocking the selected advertisement intends to *prevent viewers from becoming frustrated through being excessively exposed to the selected advertisement.* The viewers can continue, in fact, watching programs with a different set of advertisements or even free of any advertisement. This is completely different from the claimed "disabling the digital TV function."

In view of the above, Zigmond fails to disclose at least the above-mentioned limitations (i) and (ii) of independent claims 1 and 12 of the present application. Thus, independent claims 1 and 12 are patentable over Zigmond for at least the reasons set forth above. Dependent claims 2-11 and 13-15 are allowable for at least the same reasons. Accordingly, withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. 103(a)

Claims 5, 12, 13 and 15

Claims 5, 12, 13 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application Pub. No. 20020010927 ("Kim"). For at least the following reasons, the rejection is improper and must be withdrawn.

Kim does not qualify as prior art. Kim is not by "others" under 35 U.S.C. 102 as Kim has exactly the same inventorship as the present application. In addition, Kim was published (on January 24, 2002) after the filing date (December 12, 2001) of the presentation application.

Thus, Kim does not qualify as prior art under 35 U.S.C. 102(a) or 102(b).

Further, as the rejection is based on the non-provisional application publication Kim, which itself was filed on January 12, 2001, after the priority date (December 20, 2000, i.e., the filing date of the provisional Application No. 60/257,307) of the present application, Kim by itself does not qualify as prior art under 35 U.S.C. 102(e).

Furthermore, *had* the Examiner correctly attempted to use the provisional Application No. 60/176,121 (filed January 14, 2000) in place of Kim to make the rejection, the Examiner has failed to meet his or her burden to prove that the portions of Kim relied upon by the Examiner to make the rejections do enjoy the priority date of the corresponding provisional application.

Moreover, *assuming arguendo* that the portions of Kim relied upon by the Examiner enjoy the priority date of the provisional application, as Kim and the present invention were commonly owned at the time of the invention was made, as already established in a statement in a response to office action filed June 23, 2006, Kim is removed as prior art under 35 U.S.C. 103(c).

Applicant further notes that in the office action dated August 18, 2006, the previous Examiner has cited 37 C.F.R. 1.130, asserting that filing an affidavit or declaration is the only means to disqualify commonly owned patent or published application as prior art. However, as Kim would otherwise only possibly qualify as prior art under 35 U.S.C. 102(e), 35 U.S.C.

103(c), rather than 37 C.F.R. 1.130, should be applied. Actions to correct this error made by the previous Examiner in applying the laws is respectfully requested.

In view of the above, withdrawal of the rejection of claims 5, 12, 13, and 15 is respectfully requested.

Claims 9-11

Claims 9-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application Pub. No. 20040073947 ("Gupta"). Gupta was filed January 31, 2001, clearly after the priority date of the present application. Thus, the rejection is improper and must be withdrawn.

Claim 14

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Kim, and further in view of Dimitrova. As discussed earlier, Kim does not qualify, or is otherwise removed, as prior art. Thus, the rejection is improper and must be withdrawn.

Applicant reserves the right to provide further arguments/evidence in support of allowance of the claims if the claims are rejected again, or if Kim and Gupta are not removed as prior art.

CONCLUSION

For these and other reasons, it is respectfully submitted that the rejection of the rejected claims should be withdrawn, and all of the claims be allowed. Accordingly, reexamination, reconsideration and allowance of all the claims are respectfully requested.

Please direct all correspondence to **Myers Dawes Andras & Sherman LLP**, 19900 Mac Arthur Blvd., 11th Floor, Irvine, California 92612.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 19, 2007.

By Jessica A. Fisher

Signature

Respectfully submitted,

6/19/07

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